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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,698	02/13/2001	Lester Sussman		1433

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EXAMINER
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SHAAWAT, MUSSA A

ART UNIT	PAPER NUMBER
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3627

MAIL DATE	DELIVERY MODE
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11/19/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/781,698	<b>Applicant(s)</b> SUSSMAN, LESTER	
	<b>Examiner</b> MUSSA A. SHAAWAT	<b>Art Unit</b> 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-20 and 34-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-20 and 34-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Response to Amendment***

1. This action is in response to amendment filed on 05/13/2008. Claims 14 and 36 have been amended. Claims 1-13 and 21-33 have been previously cancelled. Claims 45-62 have been newly added. Claims 47-62 have been cancelled. Claims 14-20 and 34-46 are pending examination.

2. *Request for Continued Examination (RCE) filed on 04/03/2008, have been acknowledged.*

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 14-20 and 34-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 14 and 36 recite "tracking frequency..." in part (iv and vi) of claims 14 and 36, the phrase "tracking frequency" renders the claim indefinite. For the purpose of examination the phrase "tracking frequency" will be interpreted as best understood by the examiner.

The dependent claims are rejected based on their dependency from rejected independent claims 14 and 36.

5. Also claims 14 and 36 recite "(f) obtaining... (i) **printing said stored current shopping list information on a printing device attached to said consumer's first computer...** (g) **sending said current shopping list.... Said second current shipping products listed ...** (h) **sending said current shopping list... consumer for pick up....,**"

these recited steps renders the claims indefinite. It is not clear how the information if printed will be sent from consumer's first computer to an optional second store connected to said second network infrastructure, and made available for pickup or shipping. In addition applicant needs to make steps g or h in the alternative, because you can't do both it's either shipping the groceries to consumer's or having it ready for pickup. Applicant is required to make appropriate changes.

The dependent claims are rejected based on their dependency from rejected independent claims 14 and 36.

6. In addition Claims 16 and 38 are rendered indefinite by the use of the trademarked term BLUETOOTH, and by reference to the "Bluetooth radio frequency standard." MPEP § 608.01(v) states, "the examiner should hold the disclosure insufficient and reject on the ground of insufficient disclosure any claims based on the identification of the product merely by trademark or by the name used in trade." Furthermore, the "Bluetooth radio frequency standard" is indefinite, because such a standard may be subject to change over time. Examiner suggests to change the use of the trademark "Bluetooth-enabled" in claims 16 and 38 to recite the following "the portable barcode ... an infrared link and Short range radio frequency link".

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 14-20 and 34-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrovich et al, US PG Pub. No. (2003/0061113 A1) referred to hereinafter as Petrovich in view of Suzuki US Patent No. (6,129,274) referred to hereinafter as Suzuki in further view of Ruppert et al US Patent No. (5,424,524) referred to here in after as Ruppert.

As per claim 14, Petrovich teaches a method for creating a consumer's shopping list prior to entering a store, comprising *the steps of*:

(a) *Using* a portable barcode scanner (see at least Para 0103);

(b) scanning a needed product barcode or a needed product coupon barcode using said portable barcode scanner (see at least Para 0103);

(c) using one or more consumer's first computers *comprising the sub-steps of*; receiving data from, and transmitting data to, said portable barcode scanner over said *consumer's* first network infrastructure (see at least Para 0103); storing said data as shopping list information under control of said product barcode or said product coupon barcode, in a memory means (see at least Para 0103-0109, 0118); communicating with a second computer system, over a second network infrastructure to request and to receive information based on said product barcode or said product coupon barcode (see at least Para 0118 0103-0109); displaying a multiplicity of product barcodes or said product coupon barcodes, together with additional shopping list information, on said consumer's first computer display (see at least 0088, claim 78); indicating on said first computer display that said consumer has obtained said shopping list information in-hand from said consumer's first computer (see at least Para 0103-0109); and indicating

that said data transmitted to and said data received from said portable barcode scanner has been successfully sent and received (see at least Para 0103-0109);

(d) Transferring said scanned product barcode or said product coupon barcode to said consumer's first computer, over said first network infrastructure ((see at least Para 0118, 0103-0109));

(e) Storing said transferred product barcode or said product coupon barcode in a shopping list database on said consumer's first computer, said shopping list database includes other product information (see at least Para 0012, 0020, 0068);

(f) Obtaining in-hand said stored shopping list from said consumer's first computer in order to go to a first store and purchase products listed on said shopping list, said obtaining in-hand is selected from the group comprising: printing said stored shopping list on a printing device attached to said consumer's first computer (see at least Para 0005), transferring said stored shopping list to a consumer's portable computer device, and using said portable barcode scanner (see at least Para 0012, 0016, 0017, 0103-0109); and

(g) Sending said current shopping list information from said consumer's first computer to an optional second store connected to said second network infrastructure, said second store shipping products listed on said shopping list to said consumer, thereby not requiring said consumer to shop in-store for said products, (see at least Para 0005, 0103-0109); and

(h) Sending said current shopping list information from said consumer's first computer to an optional second store connected to said second network infrastructure,

said second store making said products listed on said current shopping list information available to said consumer for pick up, (0103-0109).

Although Petrovich teaches wherein the home computer includes a price lookup table, a prior shopping lists or other scanning data for ordering and other functionality, Petrovich does not expressly teach *tracking frequency that said product barcode has been received from said portable barcode scanner over said first network infrastructure; providing a specific notification of previous shopping list information stored in said memory without needing a current scanned entry of one or ore barcodes associated with said previous shopping list information; adding automatically a list of one or more products stored in said previous shopping list information to said current shopping list information at said tracking frequency at said time of creating said current shopping list information.*

However Suzuki teaches wherein the processor based on customer's shopping istory information (i.e. previous shopping list) is able to make purchase recommendations for replenishment items by analyzing the last purchase date of a necessity item from the shopping history (i.e. tracking frequency and providing notification of previous shopping list information stored in memory). For example the processor determines that a substantial period of time had past since the customer last purchased necessities such as milk, butter, eggs, and the like. Accordingly the processor would display a replenishment item recommendation list to the customer (i.e. adding automatically list of one or more products stored...) (see at least col. 14 lines 1-35). It would have been obvious to one of ordinary skill in the art at te time the invention

was made to incorporate the teachings of Suzuki to the disclosure of Petrovich in order to remind the customer to refill or replenish frequently needed items such as milk eggs etc.

Both Petrovich nor Suzuki do not teach wherein said other product information includes: a product description, a product cost, and an indicator for a required quantity of said product, date and time. However Ruppert teaches wherein said other product information includes: a product description, a product cost, and an indicator for a required quantity of said product. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the disclosure of Petrovich in view of Suzuki to include the time and date of when the barcode was scanned, in order to create an efficient shopping list for the customer. In addition, the recording the date and time of when barcode was scanned is well known and old in the art at the time the invention was made as stated in the previous action, and is admitted prior art since applicant failed to properly traverse the Official notice in the previous action. Same motivation as above

As per claim 15, Petrovich teaches a portable barcode scanner of claim 14, wherein said first network infrastructure is *a wireless link between said portable barcode scanner and said consumer's first computer* (see at least Para 0067).

As per claim 17, Petrovich teaches a portable barcode scanner of claim 14, wherein said first network infrastructure is a wired link between said portable barcode scanner and said consumer's first computer (see at least Para 0067).



As per claim 18, Petrovich teaches a portable barcode scanner of claim 17, wherein said wired link is selected from the group comprising: an RS-232 link, a USB link, a parallel link and an IEEE 1394 link (see at least Para 0132).

As per claim 19, Petrovich teaches a first computer of claim 14 is selected from the group comprising: a personal computer, a personal digital assistant, an Internet appliance, and a cell phone (see at least Abstract, Para 0012-0017).

As per claim 34, Ruppert teaches the portable computer device of claim 14 is selected from the group consisting: a personal digital assistant and a cell phone (see at least Abstract, Para 0012-0017).

As per claim 35, Rupert teaches a shopping list of claim 14 is selected from the group comprising: beauty aids, books, clothing, computer hardware, computer software, computer supplies, drugs, footwear, groceries, gifts, health aids and music (see at least Para 0060 or 0103).

As per claims 20 and 42, Petrovich teaches wherein said second network infrastructure is the internet (see at least Para 0014-0016, 0060).

As per claim 16 and 38, Petrovich teaches wherein said wireless link is selected from the group comprising: an infrared link and a Bluetooth-enabled radio-frequency link (see at least Para 0114 and 0060). In addition Official notice was taken in the previous action that radio frequency using Bluetooth technology is well known and old in the art, since applicant failed to properly traverse the Official notice it becomes admitted prior art by applicant as stated in the previous action..

9. As per claims 36-37, 39-41, and 43-46, the limitations of claims 36-37, 39-41, and 43-46, are similar to the limitations of claims 14-15, 17-19, and 34-35; therefore the are rejected under the same rationale.

### ***Response to Arguments***

10. Applicant's arguments with respect have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form 892 for cited references.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MUSSA A. SHAAWAT whose telephone number is (571)272-2945. The examiner can normally be reached on Mon-Fri (8am-5:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mussa A Shaawat/  
Examiner, Art Unit 3627  
October 30, 2008

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art Unit 3627